

REMARKS

Applicant wishes to thank the examiner for the many courtesies extended in promptly retrieving the case and conducting an interview in response to the undersigned's call on August 3, 2006, with respect to his office action letter dated May 5, 2006.

Claim Rejections – 35 USC § 102

Claims 1-3 and 5 stand rejected under 35 USC 102(e) as being anticipated by O'Connor (US Reissued Pat. No. RE38,762). And claim 6 stands rejected under 35 USC 102(b) as being anticipated by Paul (US Pat. No. 5991875). Prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim. Jamesbury Corp. v. Litton Indus. Products, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985); Atlas Powder Co. v. du Pont, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); American Hospital Supply v. Travenol Labs, 745 F.2d 1, 223 USPQ 577 (Fed. Cir. 1984).

As discussed in the interview of August 3, 2006, claims 1 and 6 are herein amended to incorporate an additional claim limitation not taught by O'Connor or Paul. More specifically, both claim 1 and claim 6 now incorporate the additional limitation of “*the configuration mechanism allowing a system administrator to manage the computer system remotely independent of an on or off status of the computer system.*” This limitation is supported by the remote supervisor adapter 70 discussed in the specification at paragraphs 0013 and 0014 of the published application and illustrated in Figure 1.

This limitation is not taught by O'Connor's CD-ROM or Paul's “configuration card” 18, and accordingly amended claims 1 and 6 are believed to be allowable under 35 USC 102(e) over

O'Connor and Paul, respectively. Claims 2, 3 and 5 are directly or indirectly dependent upon amended claim 1 and, therefore, incorporate all of its limitations. They are thus also believed to be allowable under 35 USC 102(e) over O'Connor. New claims 18-22 are also directly or indirectly dependent upon amended claim 1 and are, therefore, believed to be allowable under 35 USC 102(e) over O'Connor as well.

Claim Rejections – 35 USC § 103

Claims 7-13 stand rejected under 35 USC 103(a) as unpatentable over Paul and in view of Cepulis (US. Pat. No. 6961791). And claims 14-17 stand rejected under 35 USC 103(a) as unpatentable over Paul.

In order for a claimed invention to be rejected on obviousness, the prior art must suggest the modifications sought to be patented; In re Gordon, 221 U.S.P.Q. 1125, 1127 (CAFC 1984); ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (CAFC 1984). Further, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself. In re Oetiker, 24 U.S.P.Q. 2nd 1443, 1445 (CAFC 1992).

Claim 7 is dependent upon amended claim 6 and, therefore, incorporates all of its limitations. As discussed above, claim 6 is herein amended to incorporate an additional claim limitation not taught by Paul. Thus, claim 7 now claims a PCI card (*configuration mechanism*) *allowing a system administrator to manage the computer system remotely independent of an on or off status of the computer system.*”

This limitation is not taught or suggested by Cepulis's ROM-based setup utility (RBSU) 122 or associated PCI cards 108 et seq, and thus Cepulis is not believed to modify Paul to teach the invention claimed by claim 7. Accordingly, amended claim 7 is believed to be allowable under 35 USC 103(a) over Paul and in view of Cepulis. Claims 8-13 are directly or indirectly dependent upon amended claim 6 and are, therefore, also believed to be allowable under 35 USC 103(a) over Paul and in view of Cepulis.

Claim 14 has been amended to depend from claim 12, and is thus now indirectly dependent upon amended claim 6 and, therefore, is also believed to be allowable under 35 USC 103(a) over Paul and in view of Cepulis. Claims 15-17 have been canceled.

Double Patenting

Claims 6-8, 10, 11 and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 4-8 and 11 of co-pending application Serial No. 10/748,431. Claims 6-12 and 14-17 are similarly provisionally rejected on said nonstatutory obviousness-type double patenting over claims 1-6 of said co-pending application Serial No. 10/748,431. And claims 6-8, 10 and 11 are similarly provisionally rejected on said nonstatutory obviousness-type double patenting over claims 6-9 of said co-pending application Serial No. 10/748,431.

A terminal disclaimer is filed herewith with respect to said commonly-owned co-pending application Serial No. 10/748,431, and the provisional rejection is believed to be obviated.

Allowable Subject Matter

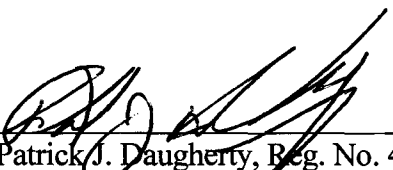
Claim 4 stands objected to as being dependent upon a rejected base claim, "but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Claim 4 has been amended into independent form to incorporate all of the limitations of original base independent claim 1 and intervening original dependent claim 2. Thus, claim 4 has been amended corresponding to the examiner's remarks in his letter of May 5, 2006, and is believed to be in condition for allowance.

Conclusion

For the above reasons, each of the claims now in the application is distinguishable one from the other and over the prior art. Therefore, reconsideration and allowance of the claims are respectfully requested.

Respectfully submitted,

Date: August 7, 2006

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